



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/965,398      | 09/28/2001  | Jess Baker           | BS01-231            | 5490             |

7590 07/14/2006

Withers & Keys LLC  
PO Box 71355  
Marietta, GA 30007-1355

EXAMINER

NGUYEN, QUYNH H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2614     |              |

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|------------------------------|------------------------|---------------------|--|
|                              | 09/965,398             | BAKER ET AL.        |  |
| Examiner                     | <b>Art Unit</b>        |                     |  |
| Quynh H. Nguyen              | 2614                   |                     |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on pre-brief conference filed 4/27/06.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-5 and 7-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-5 and 7-19 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

## **DETAILED ACTION**

This Office action is in response to the pre-appeal request filed 4/27/06.

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 2, line 4 the term "should" does not make sense; it appears that it should be - -shoulder- - to be consistent with the rest of the claims.

### ***Claim Rejections - 35 USC § 103***

4. Claims 1-3, 7-11, 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keenum et al (US PAT. NO. 6,904,149 hereinafter Keenum) in view of McKinnon et al (US PAT. NO. 5,414,768 hereinafter McKinnon).

As to claims 1, 7, 11, Keenum discloses a telephone comprising a housing (16 see Fig. 1), POTS circuitry disposed within the housing (inherent but not

shown), a filter cartridge 10. The filter cartridge comprising: at least one electrical connector (33) for engaging the corresponding connector for the POTS circuitry disposed in the telephone, a first connector (38) for receiving a DSL line and at least one second connector (29) for receiving the telephone line (13) wherein the filter cartridge comprises circuitry to receive both DSL and POTS signal from telephone line and to filter the DSL signal to only pass the POTS signal to the at least one electrical connector (33) and to simultaneously pass the DSL signal to the at least one connector (38) for receiving the DSL line.

Keenum differs from the claimed invention in not disclosing the first (38) and second connectors (29) are located on the same second side. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Keenum to have the first and second connectors on the same second side, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Furthermore, such a configuration would allow a desktop telephone to use the filter cartridge and provide simultaneous connection to a DSL device located on the same desktop.

Keenum although discloses the telephone housing back (location) engages the filter cartridge, Keenum as modified above differs from the claimed invention in not disclosing the location is within the telephone housing adapted to engage the filter cartridge.

However, it is old and well known in the art for a telephone housing to comprise a location within the telephone adapted to engage auxiliary devices, for

example see McKinnon. McKinnon discloses option bay within a telephone for receiving optional modules (e.g. 206 in Fig. 5) [a location within the telephone adapted to engage auxiliary devices] such that the user can add expansion modules to the telephone and be cosmetically appealing. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Keenum to comprise a location within the telephone housing adapted to engage the filter cartridge such that the cartridge is easily installed by the user and be cosmetically appealing (e.g. McKinnon col. 1 lines 65-67).

As to claims 2, 8, 16-19, it is old and well known in the art for connectors such as the telephone jack (RJ-11) connector to comprise a shoulder for securely holding the telephone jack to the telephone. (Note that the RJ-11 jack configuration is similar to applicant's connector as disclosed in applicant's Figs. 4, 5.) Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Keenum as modified by McKinnon above to further comprise a connector having shoulders (similar to that of the RJ-11 connector) to securely affix the cartridge to the telephone and provide a simple way of easily removing the cartridge.

As to claims 3, 9, Keenum teaches the filter cartridge is easily removable.

As to claims 10, 14, 15, note Keenum's DSL connector 38.

5. Claims 4, 5, 12, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keenum as modified by McKinnon as applied to claims 1-3, 7-

11, 14-19 above, and further in view of the admitted prior art (applicant's specification, page 8, lines 2-3 of paragraph [0032]).

Keenum as modified by McKinnon differs from the claimed invention in not disclosing the use of a three-position switch for ejecting the filter cartridge. However, it is old and well known in the art to use a three position switch system for ejecting PCMCIA cards and that such a design is conventional as is admitted by applicant; note the admitted prior art on page 8, lines 2-3 of paragraph [0032] discloses that PCMCIA latching design is conventional. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Keenum as modified by McKinnon to comprise such a conventional means for effectively holding and ejecting the filter cartridge.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Larson et al (US PAT. NO. 6,408,068) discloses a telephone having module slots for receiving option modules.

Gumb et al (US PAT. NO. 4,061,411) discloses a multi-outlet adaptor for plug-in telephones.

Kotani et al (US PAT. NO. 5,163,089) discloses a telephone having a removable cartridge.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-5 and 7-19 have been considered but are moot in view of the new ground(s) of rejection.
  
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 571-272-7489. The examiner can normally be reached on Monday - Thursday from 6:15 A.M. to 5:45 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan, can be reached on 571-272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Quynh H. Nguyen*  
**Quynh H. Nguyen**  
**Patent Examiner**  
**Art Unit 2614**